

REMARKS/ARGUMENTS

Status of the Application

In the March 19, 2008, Non-Final Office Action, Claims 1-13 and 30-32 were pending and rejected. In the present response, Claim 1 has been amended to remove a limitation added by amendment in the December 18, 2006, Response to the April 21, 2006, Final Office Action. Support for the present form of Claim 1 can be found in original Claim 1. Thus, Claims 1-13 and 30-32 are pending. No new matter was added.

Claim amendment

As stated above, the present amendment to Claim 1 removes a limitation added by amendment in the December 18, 2006, Response to the April 21, 2006, Final Office Action. A review of all correspondence received from the Patent Office in regard to this application since the addition of that limitation (i.e., the March 16, 2007, Non-Final Office Action; the August 21, 2007, Final Office Action; the December 14, 2007, Advisory Action; and the March 19, 2008, Non-Final Office Action) demonstrates that the same references have been cited against the present application during that entire period, namely WO 02/083794 to Phillipoz *et al.* (hereinafter “Phillipoz PCT”) and U.S. Patent No. 6,068,922 to Vercesi *et al.* (hereinafter “Vercesi”). Moreover, such a review demonstrates that the addition and/or presence of the limitation currently being removed was not deemed by the Examiner to overcome these references in any way during all of the above identified correspondence. As such, Applicants submit that the present amendment to Claim 1 should not have any effect on Examiner’s opinion of the allowability of the present application.

Rejections Under 35 U.S.C. § 103

Claims 1-8, 11-13, and 30-31 were rejected under 35 U.S.C. § 103(a) as being obvious over Phillipoz PCT. More specifically, Examiner asserts that, while this reference does not specifically disclose all limitations of the present claims, the limitations not specifically taught by Phillipoz PCT would have been obvious to one skilled in the art given the disclosure of that reference. Examiner further rejected Claims 9-10 and 32 under 35 U.S.C. § 103(a) as being obvious over Phillipoz PCT in

view of Vercesi. More specifically, Examiner asserts that Phillipoz PCT discloses and/or makes obvious all limitations of the base claim, as discussed above, asserts that Vercesi teaches the additional limitations of Claims 9-10 and 32, and that it would have been obvious to one skilled in the art to combine Vercesi with Phillipoz PCT to arrive at the present invention. Applicants herein demonstrate that Phillipoz PCT is not prior art to the present application and, as such, cannot make obvious the present invention. Applicants further demonstrate that, had Examiner cited the U.S. counterpart to Phillipoz PCT instead, this reference still would not preclude patentability of the present invention.

In defining the conditions for patentability, 35 U.S.C. § 102 sets forth the several categories of prior art. More specifically, 35 U.S.C. § 102 states in pertinent part as follows:

A person shall be entitled to a patent unless

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or . . .
- (d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or
- (e) the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Moreover, as these various categories of prior art are treated slightly differently than one another, it is necessary to determine which category of prior art a reference falls within.

The Phillipoz PCT reference cited by Examiner is a published foreign patent application that has a publication date of October 24, 2002. The present application has a filing date of March 25, 2004, but claims priority to U.S. Provisional Patent Application No. 60/467,342, which has a filing date of May 2, 2003. As such, while Phillipoz PCT is “a printed publication in . . . a foreign country,” that reference is not dated “more than one year prior to the date of the application for patent in the United States,” thus making Phillipoz PCT not prior art to the present application under 35 U.S.C. § 102(b).

Moreover, the U.S. counterpart application to Phillipoz PCT, U.S. Patent Application No. 09/833,346 (hereinafter “Phillipoz US”), to which Phillipoz PCT claims priority, never granted as a patent and has a publication date of December 12, 2002 (see U.S. Patent Application Publication No. 2002/0187291). Thus, Phillipoz US also cannot be deemed to have “patented or described in a printed publication [the present invention] in this or a foreign country . . . *more than one year prior* to the date of the application for patent in the United States,” making Phillipoz US also not prior art to the present application under 35 U.S.C. § 102(b).

In addition, neither Phillipoz PCT nor Phillipoz US can be held as prior art under 35 U.S.C. § 102(d), as neither of these references are a “patent . . . [or] an inventor’s certificate,” as required by this section. Further, even if a patent were to issue from the Phillipoz PCT reference at this time, that patent could not possibly issue “prior to the date of the [present] application for patent in this country,” which is again required by this section. As such, neither Phillipoz US nor Phillipoz PCT or any patents issuing therefrom can be deemed prior art under 35 U.S.C. § 102(d).

Moving now to 35 U.S.C. § 102(a), to be a prior art reference under this section the reference must be a “patent[] or . . . a printed publication in this or a foreign country, before the invention thereof by the applicant for patent.” Clearly, both Phillipoz PCT and Phillipoz US are a “a printed publication in this or a foreign country.” Further, both of these references were published prior to the priority date of the present application. However, neither of these references are before the *invention* by the present Applicant. In the attached declaration submitted by the

inventors of the present application under 37 C.F.R. § 1.131, evidence is provided of conception of the presently claimed invention as well as the reduction to practice of various embodiments of the invention possessing from 0.05-0.5% microfiber prior to the publication dates of Phillipoz PCT (October 24, 2002) and Phillipoz US (December 12, 2002). In light of this declaration, neither Phillipoz PCT nor Phillipoz US can be deemed a prior art reference to the present application under 35 U.S.C. § 102(a).

As for prior art under 35 U.S.C. § 102(e), this section deals specifically with patents and patent applications "filed in the United States." However, in addition to patents and applications actually filed in the U.S., this section also states that "an international application filed under the treaty defined in section 351(a) [PCT] shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language." Phillipoz PCT, the reference actually cited by Examiner, is a PCT patent application that does not designate the United States, as evidenced by the face page of that reference. As such, Phillipoz PCT cannot be a prior art reference under 35 U.S.C. § 102(e). Thus, Phillipoz PCT is not prior art to the present application under any of the relevant sections, so any rejections based upon this reference are improper.

In contrast, Phillipoz US is "an application for patent, published under section 122(b), by another filed in the United States" for which Applicants have not attempted to establish date of invention prior to the effective date of the reference under this section, i.e. the filing date of the Phillipoz US application. Thus, while Phillipoz US is not prior art under any other section, it could be prior art under 35 U.S.C. § 102(e). However, even if Examiner had cited Phillipoz US (in place of Phillipoz PCT) against the present application in the present obviousness rejection under 35 U.S.C. § 103, this reference would still not preclude patentability of the present application. 35 U.S.C. § 103(c)(1) states that "[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person." Here, as demonstrated by the analysis above,

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Phillipoz US could not qualify as prior art to the present application under any section except 35 U.S.C. § 102(e). Further, Phillipoz US is clearly “[s]ubject matter developed by another person,” as Phillipoz US and the present application have different inventive entities. Lastly, the present application and Phillipoz US were at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person, as indicated in the following statement:

Application 10/809,470 and U.S. Patent Application were, at the time the invention of U.S. Patent Application No. 09/833,346 was made, owned by and/or subject to assignment to E.I. duPont de Nemours & Company.

As such, the present obviousness rejection involving Phillipoz US would not preclude patentability of the present application.

Given all of this, Applicants submit that Claim 1 of the present application should be deemed nonobvious in view of the cited references. As all other claims are dependent upon, and narrower than, Claim 1, Applicants further submit that all other pending claims should also be deemed nonobvious. Applicants therefore respectfully request that this rejection be withdrawn and all claims allowed.

Summary

In order to expedite disposition of this case, the Examiner is invited to contact Applicants' representative at the telephone number below to resolve any remaining issues. Should there be a fee due which is not accounted for, please charge such fee to Deposit Account No. 04-1928 (E.I. du Pont de Nemours and Company).

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